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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,229	11/02/2001	Norio Sakai	36856.561	8116

7590

11/06/2002

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EXAMINER

LEVI, DAMEON E

ART UNIT

PAPER NUMBER

2841

DATE MAILED: 11/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/004,229

Applicant(s)

SAKAI, NORIO

Examiner

Dameon E Levi

Art Unit

2841

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8. 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 20 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims as recited are indefinite for failing to further limit the parent claim from which they depend.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1,2,4,6-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Kwon et al US Patent 6278178.

Regarding claim 1, Kwon et al discloses an electronic component comprising:
a member having first and second main surfaces disposed opposite to each other, and
four side surfaces connecting the first and second main surfaces, at least one of the
side surfaces being provided with a recess portion extending from the first main surface
to the second main surface; and a plurality of external terminal electrodes provided in
the recess portion (for example, see element 21, 23a Fig 16C).

Regarding claim 2, Kwon et al discloses wherein each of the plurality of external
terminal electrodes are arranged so as to extend from the first main surface to the
second main surface (for example, see element 23a, Fig 16C)

Regarding claim 4, Kwon et al discloses 1, wherein a plurality of concavities are
provided in the recess portion, the external terminal electrodes are arranged so as to fill
the concavities, and surfaces of the plurality of external terminal electrodes have a
common flat surface with a bottom surface of the recess portion (for example, see
elements 23, Fig 16C).

Regarding claim 6, Kwon et al discloses the device further comprising an external
conductor film provided on at least one of the first and second main surfaces (for
example, see column 5, lines 43-46).

Regarding claim 7, Kwon et al discloses wherein each of the plurality of external
terminal electrodes has a portion extending onto at least one of the first and second
main surfaces (for example, see elements 23a, Fig 16C).

Regarding claim 8, Kwon et al discloses wherein the surface of each of the plurality of external terminal electrodes is entirely covered with a plating film(for example, see column 5, lines 43-46).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3,5 and 9-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kwon et al US Patent 6278178 in view of Ogihara et al US Patent 4764233.

Regarding claim 3, Kwon et al discloses the instant claimed invention except wherein each of the plurality of external terminal electrodes are arranged so as to extend from the first main surface towards to second main surface but not reaching the second main surface.

Ogihara et al discloses an electronic component wherein each of a plurality of external terminal electrodes are arranged so as to extend from a first main surface towards a second main surface but not reaching the second main surface (for example, see elements 2, Fig1).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have arranged the terminal electrodes as taught by Ogihara et

al in the device as taught by Kwon et al for the purpose of facilitating electrical connectivity between the different layers of the substrate.

Regarding claim 5, Kwon et al discloses the instant claimed invention except wherein the member comprises a plurality of ceramic layers laminated together, and an internal conductor film provided on an interface between the ceramic layers.

Ogihara et al discloses an electronic component wherein a member comprises a plurality of ceramic layers laminated together, and an internal conductor film provided on an interface between the ceramic layers (for example, see Fig 1, see column 8, lines 56-66).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have arranged a plurality of layers as taught by Ogihara et al in the device as taught by Kwon et al as such an arrangement is conventional in the art of manufacturing multilayered substrates.

Regarding claims 9-19, the methods disclosed therein are deemed as inherent in the assembly of the claimed apparatus of the preceding claims as fully met by the accompanying references, (Kwon et al, Ogihara et al) and are subsequently rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dameon E Levi whose telephone number is (703) 305-0426. The examiner can normally be reached on Mon.-Fri. (9:00 - 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David S Martin can be reached on (703) 308-3121. The fax phone numbers

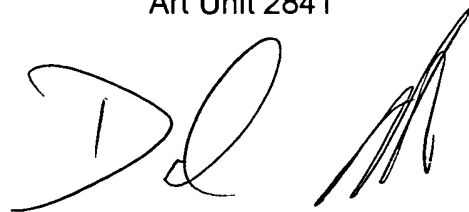
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for the organization where this application or proceeding is assigned are (703) 308-7724 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0058.

Dameon E Levi
Examiner
Art Unit 2841

DEL
November 4, 2002

A handwritten signature in black ink, appearing to read 'DM', is written over a large, faint, stylized 'A' or 'M' shape.

DAVID MARTIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800